APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,198	01/16/2004	Nobuyuki Tonegawa	00862.023404.	4895

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EXAMINER
RILEY, MARCUS T

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
09/15/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/758,198	TONEGAWA, NOBUYUKI
	Examiner	Art Unit
	MARCUS T. RILEY	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>08 September 2009</u>.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-11</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-11</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on <u>01/16/2004</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☒ All   b) ☐ Some *   c) ☐ None of:
      1. ☒ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>07/09/2008</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on September 08, 2009 has been entered.

Response to Amendment

2.   This office action is responsive to applicant's remarks received on September 08, 2009.

Claims 1-11 remain pending.

Response to Arguments

3.   Applicant's arguments with respect to claim **claims 1, 2, 6, 7 & 9 - 11** have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this
> or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5.   **Claims 1, 2, 6, 7 & 9-11** are rejected under 35 U.S.C. 102(e) as being anticipated by

Nagashima '202 (US 2002/0122202 A1 hereinafter, Nagashima '202).

   Regarding claim 1; Nagashima '202 discloses an image processing apparatus (Fig. 1,

#1000) comprising: first input unit (Fig. 1, #1020) configured to input first data created by

predetermined application software (Fig. 3, Step S1, Page 4, Paragraph 0059)

   second input unit (Fig. 1, #1030) configured to input second data, to which the first data is

converted wherein the second data is image data of a predetermined format (Fig. 3, Step S2, Page 4,

Paragraphs 0059-0061 and Page 5, Paragraph 0063)

   registration unit (Fig. 2, #1073) configured to register the first and second data (Fig. 2,

Registration Files A&B) in a database (Fig. 2, Information Management DB) in correspondence with a specific

index (Fig. 6 & 7 where Fig. 6 & 7 is a diagram showing the structure of files stored in the registration file A & B

respectively);

   wherein the first and second data are registered in the database simultaneously but

individually (See Fig. 2 where Fig. 2 shows is a diagram showing a state in which two coversheet template registration files

are stored in an information management database DB);

   a transmitting unit (Fig. 1, #1072, Cover Sheet Generating Section) configured to transmit data to an

external apparatus (Cover Sheet Generating Section generates data to be transmitted to the printing apparatus 2000 or

3000. Page 4, Paragraph 0058);

a printing unit (Fig. 1, #2000 or 3000) configured to perform print processing based on data (Fig. 1, #2000 or 3000, Page 4, Paragraph 0058);

designation unit (Fig. 1, Printer Driver of Data Control Section 1070 - Not Shown) configured to designate said transmitting unit or said printing unit as an output method of data (The printer driver sends data to a designated address. The printer driver is a program that processes printing data generated by an application or the like so that the printing data can be processed by a printer. Page 4, Paragraph 0056);

index input unit (Fig. 1, #1071, Coversheet Template Producing Section) configured to select the specific index (Fig. 3. Step S2 and Fig. 4 Steps S300-S307. Page 5, Paragraph 0063-0069);

and a selecting unit (Fig. 3, Step S4) configured to select the first data, but not the second data, corresponding to the specific index input by said index input unit in a case where said transmitting unit is designated by said designation unit, and to select the second data, but not the first data, corresponding to the specific index input by said index input unit in a case where said printing unit is designated by said designation unit; and (Figs. 5A & 5B Steps S500-S511, Page 6, Paragraphs 0072-0079).

a control unit (Fig. 1, #1070 Data Control Section) configured to control said transmitting unit to transmit the first data selected by said selecting unit and to control said printing unit to perform print processing based on the second data selected by said selecting unit (Data Control Section #1070 controls Cover Sheet Generating Section #1072 that generates data to be transmitted to the printing apparatus 2000 or 3000. Page 4, Paragraph 0058; See also Fig. 3 Step S4 and Fig. 5 Steps S502 & S503, Page 6, Paragraph 74);

Regarding claim 2; Nagashima '202 discloses wherein said printing unit prints an image obtained by synthesizing information representing the index and the second data input by said second input unit (Figs. 5A & 5B Steps S500-S511, Page 6, Paragraphs 0072-0079);

and wherein said index input unit selects the information representing the index by reading, by a reading device (Fig. 1, #1050 Storage Medium Reading Device) the image which is obtained by synthesizing the information representing the index and the data input by said second input unit and is printed by said printing unit (Figs. 5A & 5B Steps S500-S511, Page 6, Paragraphs 0072-0079. See also Page 4, Paragraph 0056).

Regarding claim 6; Nagashima '202 discloses wherein when the output method designated by said designation unit is printing by said printing unit (Fig. 1, #2000 or 3000, Data Control Section 1070 transmits data to printing apparatus 2000 or 3000 to be printed. Page 4, Paragraph 0058);

said selecting unit selects the second data and causes said printing unit to print an image based on the second data (Figs. 5A 5B Steps S500-S511, Page 6, Paragraphs 0072-0079).

Regarding claim 7; Nagashima '202 discloses when the output method designated by said designation unit is transmission by said transmission unit, said selecting unit causes said transmission unit to transmit the first data (Fig. 3, Steps S1-Steps S7, Page 4, Paragraph 0058);

Regarding claim 9-11; Claims 9-11 contain substantially the same subject matter as claim 1. Therefore, claim 9-11 are rejected on the same grounds as claim 1.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   **Claims 3-5 & 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nagashima '202 (US 2002/0122202 A1 hereinafter, Nagashima '202) in combination with Ett

(US 5,227,893 hereinafter, Ett '893).

Regarding claim 3; Nagashima '202 as modified does not expressly disclose where the

information representing the index is expressed by a barcode.

Ett '893 discloses where the information representing the index is expressed by a barcode

(See Fig. 5 where Fig. 5 shows a flow diagram for the reception of a facsimile image which contains the indexing/routing

information in pseudo code bar form.).

Nagashima '202 and Ett '893 are combinable because they are from same field of

endeavor of image processing apparatuses (*"It is another object of the present invention to incorporation of said

code pattern into the image portion of a facsimile or other image transmission in such a manner as to be transparent to the

system, the network, and users."* Ett '893 at column 2, lines 25-29).

At the time of the invention, it would have been obvious to a person of ordinary skill in

the art to modify image processing unit as taught by Nagashima '202 by adding where the

information representing the index is expressed by a barcode as taught by Ett '893. The

motivation for doing so would have been to permit the embedding of data needed for indexing,

or further routing, within the image in machine readable form, which is transparent to the users.

Therefore, it would have been obvious to combine Nagashima '202 with Ett '893 to obtain the

invention as specified in claim 1.

Regarding claim 4; Ett '893 discloses where the information representing the index is

expressed by a character string (See Fig. 3 where Fig. 3 shows a typical string of bar codes in code 39, with a start

character 78, data characters 80, a check data character 82, and a stop character 84. Column 6, lines 34-39).

Regarding claim 5; Ett '893 discloses where the information representing the index is

expressed by each character spacing in a predetermined character string (See Fig. 3 where Fig. 3 shows a

typical string of bar codes in code 39, with a start character 78, data characters 80, a check data character 82, and a stop character

84. The start 78 and stop 84 characters are identical and contain information needed to define the widths of the bars and spaces in

the ensuing code patterns." column 6, lines 34-39);.

Regarding claim 8; Ett '893 discloses where the database is constructed by a terminal

connected via a network (Fig. 1 #4000, Page 46, Paragraphs 0072-0054).

Examiner Notes

8.   The Examiner cites particular columns and line numbers in the references as applied to

the claims above for the convenience of the applicant. Although the specified citations are

representative of the teachings in the art and are applied to the specific limitations within the

individual claim, other passages and figures may apply as well. It is respectfully requested that,

in preparing responses, the applicant fully considers the references in its entirety as potentially

teaching all or part of the claimed invention, as well as the context of the passage as taught by

the prior art or as disclosed by the Examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCUS T. RILEY whose telephone number is (571)270-1581. The examiner can normally be reached on Monday - Friday, 7:30-5:00, est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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